

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of

CLARK et al.

U.S. Patent No. 7,569,602 B2; issued August 4, 2009

Atty. Ref.: 620-432; Confirmation No. 1721

Appl. No. 10/576,095

TC/A.U. 1626

Filed: April 14, 2006

Examiner: SHAMEEM, Golam M.

For: FURAN DERIVATIVES AS EP4 RECEPTOR ANTAGONISTS

* * * * *

September 11, 2009

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Office of Patent Legal Administration

Sir:

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
PURSUANT TO 37 CFR § 1.705(d)

This Request for Reconsideration of Patent Term Adjustment is being filed within two (2) months of the issue date of the above-identified patent. This Request concerns issues that arose after payment of the issue fee. Therefore this Request is timely (37 CFR 1.705(d)). The fee set forth in 37 CFR 1.18(e) is being paid concurrently.

Patentees respectfully request reconsideration of the Patent Term Adjustment for this patent.

The Patent Office determined that the patent is entitled to a term adjustment of **462 days**.

The correct term adjustment is not less than **574 days**.

ISSUE PRESENTED

This patent is entitled to a term extension equal to the sum of: (A) Office delays in taking certain actions; and (B) the amount of time, in excess of three years from the filing date, that it took for the patent to be issued.

The Patent Office Patent Term Adjustment calculation indicated on the issued patent fails to include the additional amount of time in excess of three years from the filing date that it took for the patent to be issued, as required by 35 U.S.C. § 154(b)(1)(B).

LAW OF PATENT TERM ADJUSTMENT

The term of a patent is extended for the number of days that issuance of the patent was delayed by failures of the Patent Office to promptly take certain actions (35 U.S.C. § 154(b)(1)(A)) (“A delays”). The term of a patent is also extended for the number of days that the Patent Office failed to issue a patent by the three-year anniversary of the date that the application for patent was filed (35 U.S.C. § 154(b)(1)(B)) (“B delay”). Relevant to the present facts, the Patent Term Adjustment is calculated by adding the “A delays” plus the “B delay,” except to the extent that the periods of delay overlap (35 U.S.C. § 154(b)(2)(A))¹. “‘B delay’ begins when the Patent

¹ There are “C delays” resulting from interferences, secrecy orders, and appeals, which are similarly treated but are not relevant to the present facts.

Office has failed to issue a patent within three years, not before.” *Wyeth v. Dudas*, 580 F. Supp. 2d 138, 142 (D.D.C. 2008). Therefore a “B delay” does not overlap with “A delays” that occurred during the first three years that a patent application was pending. *Id.* at 141.

In this case the Patent Office is believed to have calculated the Patent Term Adjustment in accordance with its earlier, contrary “position that . . . the entire period during which the application was pending before the Office . . . and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay ‘overlap’ under 35 U.S.C. 154(b)(2)(A).” 69 Fed. Reg. 34283 (June 21, 2004), as excerpted from *Wyeth v. Dudas*, 580 F. Supp. 2d 138, 140 (D.D.C. 2008). The Patent Office’s position is “inconsistent with law” (See 35 U.S.C. § 2(b)(2)) as interpreted by the court in *Wyeth*.

“A DELAYS”

Relevant to the present facts, the period of adjustment under 37 CFR 1.702(a) includes the following period:

(1) “The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application . . . fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of . . . an action under 35 U.S.C. 132. . . .” See 37 CFR § 1.703(a)(1)). The application entered national phase on April 14, 2006 and the first Office Action was mailed on September 18, 2008. The

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day after the date that is fourteen months after the application entered national phase was June 15, 2007. The Patent Office delay was **462 days**, which is the number of days in the period from June 15, 2007 to September 18, 2008.

The total “A delay” was **462 days**, which is the total Patent Term Adjustment stated on the above-identified patent.

“B DELAY”

“The period of adjustment under [37 CFR] § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which . . . the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued. . . .” See 37 CFR § 1.703(b).

The patent application commenced national stage on April 14, 2006 and the patent issued on August 4, 2009. The day after the date that is three years after commencement of national stage was April 15, 2009. And the total “B delay” was **112 days**, which is the number of days in the period from April 15, 2009 to August 4, 2009.

CALCULATION OF PATENT TERM ADJUSTMENT

All of the “A delay” occurred during the first three years that the patent application was pending. The above-noted “A delay” of **462 days** occurred prior to the period beginning on the day after the date that is three years after the date on which the

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national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued.

Accordingly, under *Wyeth*, there is no overlap between the “A delays” and the “B delay” in this case. Therefore, the period of adjustment due to Patent Office delays is **574 days**, which is the sum of the **462 days** of “A delays” and the **112 days** of “B delay.”

The period of Patent Office delay is “reduced by . . . the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution” (37 CFR 1.704), which the Office determined to be **0 days**. There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application as set forth in 37 CFR § 1.704.

Thus the total Patent Term Adjustment is not less than **574 days**.

The patent is not subject to a terminal disclaimer. 37 CFR 1.703(g).

A copy of the Patent Term Adjustment History calculation printed from the Patent Office IFW is attached.

No fee, other than the fee under 37 CFR 1.18(e), is believed to be necessary in connection with the filing of this paper. If any additional fee is required, the Director is authorized to charge the additional fee to Deposit Account No. 14-1140.

Grant of the present Request, correction of the Patent Office records and a Certificate of Correction or other appropriate correcting paper indicating the correct Patent Term Adjustment on the face of the issued patent are requested.

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Respectfully submitted,

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10/576,095 FURAN DERIVATIVES AS EP4 RECEPTOR ANTAGONISTS


08-27-
2009:09:44:46**Patent Term Adjustments**

Patent Term Adjustment (PTA) for Application Number: 10/576,095

Filing or 371(c) Date:	04-14-2006	USPTO Delay (PTO) Delay (days):	462
Issue Date of Patent:	08-04-2009	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	0
Post-Issue Petitions (days):	+0	Total PTA (days):	462
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
07-15-2009	PTA 36 Months		
08-04-2009	Patent Issue Date Used in PTA Calculation		
06-26-2009	Dispatch to FDC		
06-26-2009	Application Is Considered Ready for Issue		
06-25-2009	Issue Fee Payment Verified		
06-25-2009	Issue Fee Payment Received		
03-31-2009	Mail Notice of Allowance		
03-27-2009	Document Verification		
03-27-2009	Notice of Allowance Data Verification Completed		
03-27-2009	Case Docketed to Examiner in GAU		
03-12-2009	Date Forwarded to Examiner		
01-21-2009	Response after Non-Final Action		
10-31-2008	Mail Non-Final Rejection		
10-28-2008	Non-Final Rejection		
04-14-2006	Information Disclosure Statement considered		
10-17-2008	Information Disclosure Statement considered		
10-17-2008	Reference capture on IDS		
10-17-2008	Information Disclosure Statement (IDS) Filed		
10-23-2008	Date Forwarded to Examiner		
10-17-2008	Response to Election / Restriction Filed		
10-17-2008	Information Disclosure Statement (IDS) Filed		
09-18-2008	Mail Restriction Requirement	462	
09-17-2008	Requirement for Restriction / Election		
12-08-2007	Case Docketed to Examiner in GAU		
06-14-2007	PG-Pub Issue Notification		
04-14-2007	IFW TSS Processing by Tech Center Complete		
01-30-2007	Miscellaneous Incoming Letter		
04-14-2006	Request for Foreign Priority (Priority Papers May Be Included)		
04-14-2006	Information Disclosure Statement (IDS) Filed		
04-14-2006	Information Disclosure Statement (IDS) Filed		

04-14-2006	Preliminary Amendment	
03-28-2007	Application Dispatched from OIPE	
04-14-2006	371 Completion Date	
03-14-2007	Sent to Classification Contractor	
03-14-2007	Notice of DO/EO Acceptance Mailed	
05-16-2006	Cleared by OIPE CSR	
04-14-2006	Initial Exam Team nn	

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